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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,827	08/02/2006	Bernd Proft	DNAG-323	4966

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EXAMINER	
CHEUNG, WILLIAM K	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
11/04/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/582,827	PROFT ET AL.	
	Examiner	Art Unit	
	WILLIAM K. CHEUNG	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 August 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The examiner acknowledges the amendment filed August 13, 2009. Claims 1-10 have been cancelled. Claims 11-20 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 11-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Podwirny et al. (WO 98/05421) for the reasons adequately set forth from paragraph 5 of the office action of March 19, 2009.

> 11. (previously presented) A process comprising producing a catalyst preparation by comminuting a catalyst containing at least one inorganic compound which is solid under standard conditions with a dispersion unit into particles having a maximum average particle size $d_{50.3}$ of 2μm, implemented in accordance with DIN 66141 and DIN 66144, and is distributed at a concentration of from 1 to 50 wt.%, relative to the finished catalyst preparation, in a liquid.

Podwirny et al. (abstract) disclose a process for producing catalyst components by comminuting a catalyst in an agitated mill loaded (page 7, line 21 ti page 8, line 13) with comminuting media, fluid vehicle, dispersion agent and particles of a metal or metal compound for passivation of metal-contaminated cracking catalysts. The volumetric average particle size of the milled particles are less than 0.5 micron, preferably less than 0.25 micron, more preferably less than 0.1 micron (page 4, line 15-21).

Podwirny et al. (page 9, line 30-35; page 22, claim 19) clearly disclose that barium titanate is suitable for the disclosed process. Although the formula of the disclosed barium titanate is not explicitly disclosed, in view of the same chemical name and terminology are being used for the disclosed barium titanate and the claimed titanate, the examiner has a reasonable basis that the claimed formula is inherently possessed in the barium titanate of Podwirny et al.

Regarding the loading requirement of claim 12, Podwirny et al. (page 12, line 16-22) clearly disclose the catalyst loading for the milling process, by indicating that 10 to 60 weight percent loading is acceptable.

Regarding claim 16, Podwirny et al. (page 7, line 33-34) clearly disclose the use of a ball mill, which is an example of a rudimentary agitated media mill.

Regarding claim 17, Podwirny et al. (page 4, line 32; page 5, line 1-2; page 23, claim 23-24, 28) clearly teach using alcohols such as methanol, ethanol and isopropanol, and water as fluid vehicles.

Podwirny et al. (page 4, line 15-21) disclose that the volumetric average particle size of the milled particles are less than 0.5 micron, preferably less than 0.25 micron, more preferably less than 0.1 micron, although Podwirny et al. do not indicate that the test method for obtaining the particle size results, because the different methods are using the same unit dimension for describing particle size disclosed in Podwirny et al. and as claimed, and the particles are significantly lower that than the particle size as claimed, the examiner has a reasonable basis that the claimed particle sizes by the claimed test method (DIN 66141 and DIN 66144) are inherently possessed by the particle sizes disclosed in Podwirny et al. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

Regarding claim 18, Podwirny et al. (page 1, line 8) disclose the catalyst is a cracking catalysts, which is well-known for the rearrangement reaction of olefins.

Further, regarding claims 18-20, since the claims as written do not contain any specific processing steps for carrying out the intended uses of the claims, claims 18-20 are considered claims that merely reciting the intended uses of the claimed catalyst products prepared by the process of claim 11. Regarding intended use, applicants must recognize that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Response to Arguments

5. Applicant's arguments filed August 13, 2009 have been fully considered but they are not persuasive. Applicants argue that Podwirny et al. do not teach the process as claimed because the process as claimed is not a passivation process for catalyst. However, applicants fail to recognize that Podwirny et al. disclose all the processing steps being claimed. Regarding applicants' argument that the claimed process invention exclude the passivation process of Podwirny et al., applicants fail to recognize that the claims as written do not support such argument. Applicants must recognize that passvating catalyst is also a process for preparating catalyst. Therefore, the examiner has a reasonable basis to maintain the rejection set forth.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM K. CHEUNG whose telephone number is (571)272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William K Cheung/
Primary Examiner, Art Unit 1796

William K. Cheung, Ph. D.
Primary Examiner
November 2, 2009